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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,648	01/29/2004	James A. Hoxie	53893-5046-00	6515

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EXAMINER

BOESEN, AGNIESZKA

ART UNIT	PAPER NUMBER
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1648

MAIL DATE	DELIVERY MODE
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02/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/767,648

Applicant(s)

HOXIE ET AL.

Examiner

Agnieszka Boesen

Art Unit

1648

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-72 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6, 8, 9, 11, 14, 15 and 17-72 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 10, and 13 is/are allowed.
- 6) ☒ Claim(s) 12 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2008 has been entered.

Claim 7 was canceled. Applicant is required to delete the text of canceled claim 7. Rejections of canceled claim 7 are moot. Claims 1, 10, and 12 have been amended. Claims 1-4, 10, 12, 13, and 16 are under examination.

Claim Rejections - 35 USC § 112

Rejection of claims 1-4, 10, 12, 13, and 16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** in view of Applicant's amendment.

New Rejection in view of Applicant's amendment.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are rejected because it is not clear what is the difference in scope between claims 12 and 16. It is also noted that in claim 12 Applicant refers to a polypeptide sequence of SEQ ID

NO: 11 as a nucleic acid sequence. Thus it is not clear if Applicant intended to recite "an amino acid sequence" when referring to SEQ OD NO: 11, or if Applicant intended to recite a different SEQ ID NO. Examiner presumes that Applicant intended to recite "an amino acid sequence" when referring to SEQ OD NO: 11.

Claim 16 is drawn to the isolated nucleic acid that encodes an amino acid sequence of SEQ ID NO: 11. Claim 16 depends from independent claim 1, which is drawn to an isolated nucleic acid encoding gp120 polypeptide comprising a deletion of hypervariable loop 3 and further comprising a compensatory mutation at amino acid residue 391.

Claim 12 is drawn to an isolated nucleic acid encoding gp120 polypeptide comprising a deletion of hypervariable loop 3 and further comprising a compensatory mutation wherein the nucleic acid sequence is SEQ ID NO: 11. Thus it appears that the scope of claims 12 and 16 is the same. Clarification is required.

Furthermore, for the purpose of clarity and in order to facilitate further search and examination, Examiner requests Applicant to explain if SEQ ID NO: 11 comprises only a deletion in hypervariable loop 3 or if it also comprises a compensatory mutation as required by claims 1 and 12. If SEQ ID NO: 11 comprises both, the deletion in hypervariable loop 3 and the compensatory mutation, Applicant is required to clarify which particular compensatory mutations are comprised within SEQ ID NO: 11.

Rejection of claims 1-4, 10, 12, 13, and 16 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement **is withdrawn** in view of Applicant's amendment.

Claim Rejections - 35 USC § 102

Rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Hasel et al. (US Patent 5,886,163) **is withdrawn** in view of Applicant's amendment.

Conclusion

Claims 1-4, 10, 13 are allowable.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnieszka Boesen whose telephone number is 571-272-8035. The examiner can normally be reached on Monday – Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Agnieszka Boesen, Ph.D./
Examiner, Art Unit 1648

/Stacy B Chen/

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Primary Examiner, Art Unit 1648